The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

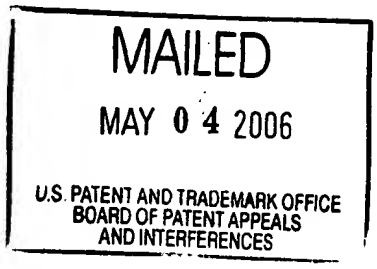
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSAN BROWNBILL,
TIMOTHY JOHN MADDEN and
MATTHEW LESLIE PEARCE

Appeal No. 2006-0861
Application 09/737,649

ON BRIEF



Before WALTZ, KRATZ, and TIMM, *Administrative Patent Judges.*

WALTZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 12, 15 and 16, which are the only claims pending in this application (claims 13 and 14 were cancelled in an amendment filed with the Brief, dated Mar. 10, 2003, which was entered as noted by the examiner in the Answer, page 2, ¶(4); see also the Brief, page 8). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to the bleaching of hair or the combined bleaching and coloring of hair, where cholesterol or its derivatives are added to the bleaching system to mitigate the damage to the hair caused by high pH (greater than 10) bleaching systems (Brief, page 9). Appellants state that the claims should be considered in two groups (Brief, page 11) and present reasonably specific, substantive arguments for the separate patentability of each group (Brief, pages 12 and 16). Therefore we select claim 1 from the first grouping and claim 7 from the second grouping and decide the grounds of rejection on the basis of these claims alone. See 37 CFR § 1.192(c)(7)(8)(2002); *In re McDaniel*, 293 F.3d 1379, 1382-83, 63 USPQ2d 1462, 1464 (Fed. Cir. 2002). Representative claims 1 and 7 are reproduced below:

> 1. A hair bleaching composition comprising:
> (a) a peroxygen compound;
> (b) a buffering agent; and
> (c) cholesterol and/or derivatives thereof or mixtures thereof; wherein the pH of the composition is greater than or equal to pH 10.3.
>
> 7. A hair colouring composition comprising the hair bleaching composition according to claim 1 and additionally a hair colouring agent.

The examiner has relied upon the following references as evidence of obviousness:

Anderson et al. (Anderson)	5,851,237	Dec. 22, 1998
Lim et al. (Lim)	5,961,666	Oct. 05, 1999

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lim or Anderson (Answer, page 3). Based on the totality of the record, we *affirm* both rejections on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

The examiner finds that Lim discloses a composition with an oxidizing agent such as hydrogen peroxide, a buffering agent such as ammonium hydroxide, a hair care additive such as cholesterol, all at a pH in the range of 5 to 11 (Answer, page 3). The examiner finds that Anderson discloses the same composition as Lim (Answer, page 4). The examiner further finds that each reference is "silent" regarding any teaching of a hair bleaching composition, a method of bleaching hair, or a hair bleaching kit (Answer, pages 4 and 5). However, the examiner finds that Anderson teaches that, due to the presence of the oxidizing agent in the coloring composition, some of the natural melanin pigment of the hair is bleached (Answer, page 5, citing col. 1, ll.

33-35). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art at the time of appellants' invention that the composition of Lim or Anderson would have been useful as a bleaching composition (Answer, pages 4 and 5).

With regard to the Group I claims (directed to bleaching compositions), appellants argue that both Lim and Anderson are directed to hair coloring compositions employing specific oxidative dyes, couplers, and a "developer" which is an oxidizing agent (Brief, page 12). Contrary to the examiner's assertion, appellants argue that Lim teaches coloring bleached hair but does not teach bleaching the hair (*id.*). Appellants further argue that Lim and Anderson are concerned with compositions that contain specific oxidative dyes that add color to the hair rather than compositions that remove color from the hair by bleaching (Brief, page 13). Appellants argue that, since both references are concerned with adding color to the hair, there would be no motivation to the artisan to pursue the chemical mixtures presently claimed (Brief, page 14, citing the paper by Janchowicz as evidence of the problem of hair damage for bleaching compositions with a pH above 10). Finally, appellants argue that there is no suggestion in Lim or Anderson to select cholesterol

from among the lanolin derivatives, pantothenic acid, and other hair care ingredients referred to by the references, nor to combine it with hydrogen peroxide at a pH of at least 10.3 (Brief, page 15).

Appellants' arguments are not persuasive. We first note that claim 1 on appeal recites the transitional phrase "comprising" which opens the claimed composition to other ingredients. *See In re Baxter,* 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981). Accordingly, giving the claim language its broadest reasonable meaning consistent with the specification as it would have been understood by one of ordinary skill in this art, we construe claim 1 on appeal as a composition capable of bleaching hair that includes at least, but possibly more, as essential elements or ingredients, a peroxygen compound, a buffering agent to bring the composition pH to greater than or equal to 10.3, and cholesterol and/or derivatives or mixtures thereof (as defined in the specification at page 7, ll. 5-11).

As correctly noted by the examiner (Answer, page 5), Anderson clearly teaches that "[a]s a consequence of the oxidizing properties of the oxidizing agent, some of the natural melanin pigment of the hair may be bleached" (col. 1, ll. 33-35). Therefore one of ordinary skill in this art would have recognized

the compositions of Anderson (and the same/similar compositions of Lim) as hair bleaching compositions in addition to hair coloring compositions. It is undisputed that Anderson and Lim teach compositions with hydrogen peroxide as the oxidizing agent, as well as ammonium hydroxide as the buffering agent, with a final composition pH in the range of 5 to 11 (e.g., see Anderson, col. 9, ll. 2-4; col. 10, ll. 38-46; see Lim, col. 4, ll. 39-42; and col. 5, l. 65-col. 6, l. 5). Contrary to appellants' argument (Brief, page 15), one of ordinary skill in this art would not have to "pluck out" cholesterol from among all the hair care additives taught by Lim or Anderson since these references only teach cholesterol as one of *three* specified hair care substances that may be added to the composition (Anderson, col. 8, ll. 5-7; Lim, col. 3, ll. 47-49). *See In re Schaumann,* 572 F.2d 312, 315-17, 197 USPQ 5, 9 (CCPA 1978); *In re Sivaramakrishnan,* 673 F.2d 1383, 1384, 213 USPQ 441, 442 (CCPA 1982). In view of our claim construction discussed above, we note that the hair coloring components taught by Lim and Anderson, e.g., oxidative dyes and couplers, are not excluded by the language of claim 1 on appeal.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a prima facie case of

obviousness in view of the reference evidence. Appellants present an argument about the "surprising result" shown by Example 1 in the specification (Brief, page 15). Accordingly, we begin anew and consider all the evidence of obviousness and non-obviousness. *See In re Oetiker,* 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992).

We fail to find the results of Example 1 (specification, pages 12-16) persuasive of non-obviousness for the following reasons. The example is limited to very specific bleaching solutions with 0.01% cholesterol added (see the Tables on pages 12 and 13 of the specification) at pHs of 9.7, 10.1 and 10.5 (specification, page 14), while claim 1 on appeal is not so limited. To be effective, a comparative showing must be commensurate in scope with the subject matter claimed. *See In re Boesch,* 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

Based on the totality of the record, including due consideration of appellants' arguments and evidence, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore, we affirm the examiner's rejection of claim 1, and claims 2-6, 9, 10, 15 and 16 which stand or fall with claim 1, under section 103(a) over Lim or Anderson.

With regard to the rejection of the Group II claims, appellants argue that Lim and Anderson restrict the hair coloring agent to specific oxidative dyes while appellants place no such limitation as both oxidative dyes and non-oxidative dyes can be utilized (Brief, page 16). Appellants further argue the selection of a narrow pH (greater than 10.3) from the broad pH range disclosed by Lim and Anderson as well as the selection of cholesterol from the list of possible hair care substances (Brief, pages 16-17).

Appellants' arguments are not well taken. Appellants admit that the oxidative dyes taught by Lim and Anderson fall within the scope of the "hair colouring agent" recited in claim 7 on appeal. Merely because the scope of appellants' claim is broader than the reference does not render the claims patentable. As discussed above, the "selection" of a hair care substance is actually very narrow, i.e., selecting cholesterol from three substances. Furthermore, the "selection" of pH is actually an overlapping range situation, where the references disclose a pH of 5 to 11 while appellants claim a pH range of greater than 10.3. Disclosure of overlapping ranges at least renders the subject matter prima facie obvious. *See In re Peterson,* 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a prima facie case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the examiner's rejection of claim 7, and claims 8, 11 and 12 which stand or fall with claim 7, under section 103(a) over Lim or Anderson.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED

THOMAS A. WALTZ)
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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CATHERINE TIMM)
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TAW/TF

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